

REMARKS

In the outstanding official action, claims 1-8 were rejected under 35 USC 103(a) as being unpatentable over Nishihara et al in view of Hanaoka et al, for the reasons of record. In response, it is respectfully submitted that there is no apparent reason to combine the cited and applied references as suggested in the Action, and that even if the references are assumed, *arguendo*, to be properly combinable, the instant invention as presently claimed is neither shown nor suggested thereby.

At the outset, it is admitted in the Action that Nishihara does not teach the specific phase-change composition required by independent claim 1 (and the remaining claims depending therefrom) but that this deficiency is overcome by Hanaoka in that it would have been obvious to modify Nishihara by forming the first recording layer of any one of the recording layer compositions taught by Hanaoka. In response, it is respectfully submitted that it would not be obvious, absent the benefit of impermissible hindsight, to select the teachings of Hanaoka to combine with the teachings of Nishihara, as there is no apparent reason to select this particular reference from the multitude of alternative teachings available absent the benefit of hindsight, and that it would require undue and impermissible experimentation to select the particular teachings of the prior art that would yield the commercially-advantageous configuration of the instant invention.

Furthermore, even if the references are assumed to be properly combinable, the instant invention as presently claimed is respectfully submitted to be clearly patentably distinguishable over the cited and applied art in various respects. Thus, for example, in the first recording layer 4 of Nishihara (deemed to be analogous to recording layer 12 in the instant application) it is stated in the Action that the reference discloses that Te is 43 atomic percent, whereas in independent claim 1 it is expressly and positively recited that the percentage of Te is between 10 and 30%. Thus, in at least this respect the instant invention as claimed is clearly patentably distinguishable over the cited and applied art.

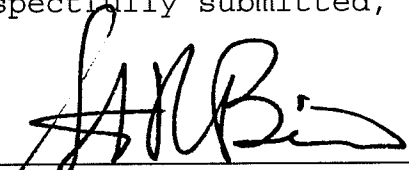
Furthermore, several parameter ranges taught in Nishihara contain values which are partially within and partially outside the permissible range of values recited in independent claim 1. Thus, for example, the thickness of the interface layers taught by Nishihara are permissibly and preferably in the range of 1nm to 10nm, with a more preferable range of 2-5nm, whereas in the analogous crystallization promoting layers of the instant invention a thickness of less than 5nm is recited, so that the reference teaches that permissible and preferred values of this parameter may be either within or outside the range of values recited. Again this would result in undue and impermissible experimentation to arrive at the instant invention as claimed absent the benefit of impermissible hindsight.

Similarly, the thickness of the first recording layer 4 (analogous to recording layer 12 in the instant application)

contains values which are both within and outside the range of values recited in claim 1, thus again requiring undue experimentation to derive the instant invention without hindsight.

In view of the foregoing arguments, it is respectfully submitted that the cited and applied references are not properly combinable, and even if combined do not render the instant invention obvious. Accordingly, it is respectfully submitted that the instant application is now in condition for allowance, and favorable consideration is earnestly solicited.

Respectfully submitted,


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